REMARKS

Claims 1-36 stand rejected in the outstanding Official Action. Claims 26, 29 and 32 have been amended and therefore Claims 1-36 remain in this application. Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached pages are captioned "**Version With Markings To Show Changes Made**."

The Examiner's acknowledgement of Applicants' claim for priority and receipt of the certified copies of the priority documents is very much appreciated. However, on the Office Action summary sheet, block 10 has been marked and the drawings filed June 21, 2000 are referenced. Both blocks "a" and "b are marked indicating that the drawings filed are both "accepted" and "objected to," respectively. Applicant contacted Examiner Daniel Hess on May 14, 2002 regarding this marking of the drawings "acceptance/ objection" status. The Examiner has indicated that he was not sure why the boxes were marked and did not remember any particular drawing problem. Pursuant to Examiner's Hess' suggestion, the issue is raised in this response and clarification is requested. Should there be no drawing correction errors, notice of acceptability of the originally-filed drawings is respectfully requested.

The Examiner notes that the application does not include suggested headings and subheadings. While the use of headings and subheadings is not required, Applicant has amended the specification to include the suggested use of headings and subheadings thereby obviating any future objection.

Claims 1-9 and 12-36 stand rejected under 35 U.S.C. § 103 as unpatentable over Bard (U.S. Patent No. 5,856,660) in view of Butterworth (U.S. Patent No. 5,010,241). Each rejected independent claim recites specific structure, i.e., a "means for projecting the light, having the imposed information content, substantially at the optical code" (apparatus claim 1, last two lines), "generating at least a luminous information substantially at the optical code" (method claim 18), "a projector of visible illumination on an area associated with said optical code in response to a result of a reading of said optical code by said optical code reader" (apparatus claim 26); and "providing, at said optical code, a visible indication of a result of said acquiring and reading step" (method claim 32).

The present invention is directed towards solving the problem of an operator of code reading equipment not being conveniently apprised of the status of the code reader of the equipment when reading optical codes. Each of Applicants' independent claims recite that the apparatus and method involves projecting an indication of the code reading result at the optical code being read. Because the operator's attention is normally focused on the optical code, the visual indication is quite convenient and expedites code reading operations.

With respect to the Bard reference, the Examiner admits that "Bard fails to show the status indication in the form of light that is projected onto the bar code." (See Section 10, page 4 of the Official Action.) The Examiner also admits that "Bard does not explicitly show a system wherein the reading result . . . is displayed to the user." (Section

13, page 4 of the Official Action.) The Examiner's admissions regarding the Bard reference are very much appreciated.

It is also observed that not only does Bard fail to show status information in the form of light projected onto the bar code, Bard specifically teaches that it is only necessary to provide a visual indication on a module worn by the operator, i.e., "second peripheral module 9" which includes "an indicator light, beeper or audio transducer 9c [which] signals the user when the decoding has been satisfactorily accomplished." (Bard column 8, lines 18-23.) Thus effectively, Bard not only fails to show status indication light [which is projected onto the bar code], it specifically teaches away from such projection by teaching that the status indication should be displayed on the peripheral module 9 which is worn by the operator and where the operator's attention is expected to be directed.

Butterworth as correctly noted by the Examiner teaches the projection of light onto a bar code from a bar code scanner so as to provide an aiming pattern on the bar code itself. Such an aiming pattern would be necessary especially when an infrared scanner is used - otherwise the operator would not know when the scanner is correctly aimed at the bar code. Butterworth specifically teaches that "a line or spots of visible light projected onto the bar code tag can be used to provide an aiming pattern, indicating that the actual area that will be optically scanned." The Examiner correctly notes that Butterworth teaches the projection of light at the bar code prior to scanning in order to aid in aiming an infrared scanner trace, i.e., **before the scanning operation takes place**.

The Examiner fails to note how or where Butterworth teaches any aiming of light for transmission of post scanning operation [having the "imposed information content"] according to Claim 1 or is an "indicator of optical code reading status" in accordance with Claim 26 or the equivalent method steps set out in Claims 18 and 32. As it has already been said that Bard clearly does not contain any such disclose and in fact "teaches away" from projecting information containing light at the bar code, it is incumbent upon the Examiner to establish how or where the Butterworth reference contains such teaching. The Examiner has failed to provide any indication or suggestion that Butterworth contains any such teaching.

The Court of Appeals for the Federal Circuit has consistently held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Court went on to note "that the PTO 'can satisfy this burden only by showing some objective teaching in the prior art . . . ." *id.* Thus, the burden is on the Examiner to show where in the prior art Applicants' claimed structures exist.

The Examiner admits that the projection of status-information-containing light onto the bar code is not present in the Bard reference and the Examiner fails to point out how or where such information containing light is projected onto the bar code in the Butterworth reference. A review of the Butterworth reference clearly indicates that this does not happen. As a result, the Office has failed to point to any "objective teaching in the prior art" of such projection in any prior art reference. Absent such a teaching, the

rejection of independent Claims 1, 28, 26 and 32 over the Bard/Butterworth combination clearly fails.

Additionally as the Court of Appeals also noted, it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." *Id.* at 1599. Here, because Bard actually teaches that the status indication should be provided on the peripheral module (worn by the operator) and not projected onto the bar code, Applicants' invention goes against the teaching of the Bard reference. As noted by the Federal Circuit this is clear error on the part of the Examiner.

Finally, the Court has consistently held that "teachings of references can be combined only if there is some suggestion of incentive to do so." *Id.* Even if there were a discussion in Bard or Butterworth of the projection onto a bar code of status information containing light, in order to combine these two references the Examiner must set out some reason or motivation for the combination. The Examiner has simply failed to address this issue.

As a result of the above, it is clear that the PTO has failed to meet the burden of establishing a *prima facie* case of obviousness of independent Claims 1, 18, 26 and 32 in view of the Bard/Butterworth combination and any further rejection thereunder is respectfully traversed.

Inasmuch as all claims depend from one of Claims 1, 18, 26 and 32, they are similarly patentable over the Bard/Butterworth combination and any further rejection thereunder is respectfully traversed.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103 over the Bard/Butterworth combination in further view of Foster (U.S. Patent No. 5,587,704). Claims 10 and 11 ultimately depend from Claim 1 and therefore the above comments regarding the Bard/Butterworth combination are herein incorporated by reference.

Applicants have reviewed the Foster reference and notes that it has nothing to do with bar code readers or the solution to the problem of visually indicating the status of a bar code reader system. Foster clearly fails to teach the projecting of any information containing light at a bar code so as to be easily seen and appreciated by the operator of the bar code reading equipment.

As a result, not even the Foster reference contains any disclosure of the structure missing from the Bard and Butterworth references, i.e., the projection of information containing visible light on the optical code surface. Clearly there is no basis for a rejection under 35 U.S.C. § 103 in view of the Bard/Butterworth/Foster combination and any further rejection thereunder is respectfully traversed.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that Claims 1-36 are in condition for allowance and Notice to that effect is respectfully requested. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of these claims, it is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Page 2, beginning at line 7:

The operation of reading a particular optical code can give negative results for various factors, among which the imperfection of the code due, for example, to damages to the label on which it is obtained, the distance between the reader and the code, or the maintenance of said distance during the scanning time. In addition, also when the code is correctly acquired, its decoding may [result] be impossible because, for example, it does not fall within the categories of codes known by the reader. In any case, the operator needs to know whether the code has been decoded before proceeding to read another code.

IN THE CLAIMS

26. (Amended) An apparatus for acquiring and reading an optical code, said apparatus comprising:

an optical code reader, having an illuminator of said optical code and a reader of said illuminated optical code[, said illuminator having a first wavelength]; and

an indicator of optical code reading status, said indicator including a projector of visible illumination on an area associated with said optical code in response to a result of a reading of said optical code by said optical code reader.

29. (Amended) An apparatus according to claim 27, wherein said visible light projector includes a light source emitting at least two chromatic components, and, in response to said [optical code reader] result, said projector emitting one of the at least two chromatic components.

32. (Amended) A method of acquiring and reading an optical code, said method comprising the steps of:

(a) acquiring and reading an optical code with an optical code reading apparatus; and

(b) providing, at said optical code, a visible indication of a result of said acquiring and reading step.